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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/430,756 10/29/99 ROBERTS

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QM12/0122

EXAMINER

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ART UNIT	PAPER NUMBER
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3711

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DATE MAILED:

01/22/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/430,756

Applicant(s)

T. Sanford Roberts

Examiner

Mitra Aryanpour

Group Art Unit

3711

 Responsive to communication(s) filed on Dec 28, 2000 This action is FINAL. Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

 Claim(s) 1-5, 7, and 8 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

 Claim(s) _____ is/are allowed. Claim(s) 1-5, 7, and 8 is/are rejected. Claim(s) _____ is/are objected to. Claims _____ are subject to restriction or election requirement.

Application Papers

 See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948. The drawing(s) filed on _____ is/are objected to by the Examiner. The proposed drawing correction, filed on _____ is approved disapproved. The specification is objected to by the Examiner. The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

 Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d). All Some* None of the CERTIFIED copies of the priority documents have been received. received in Application No. (Series Code/Serial Number) _____. received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

 Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

 Notice of References Cited, PTO-892 Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ Interview Summary, PTO-413 Notice of Draftsperson's Patent Drawing Review, PTO-948 Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

The Abstract of the Disclosure submitted on 12/28/2000 is accepted.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2, 7 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "longer member forms connected" in line 3. No clear meaning can be derived. Did applicant intend to also delete "forms" after "member"?

Claims 7 and 8 recites the limitation in the preamble (line 1) "A trajectory training aid as in claim 1". This preamble is inconsistent with the preamble of claims 1 and 4.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by **Ferrari (5,833,556)**.

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Ferrari discloses a basketball shooting aid (10) for demonstrating the correct arc for a player's ball when shooting a basket comprising: a hoop means (16) of a size to allow a player to shoot a basketball, a vertical support (11) to support the hoop means at a height over the player's head (Figure 1), and a base means (34) for attaching the support means (11) in a vertical position, and where said base means (34) supports said vertical support means (11) and hoop means (16) extends beyond said base means to allow a player to stand under said hoop like means without being interfered with by said base means.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ferrari (5,833,556)** in view of **Barnes, Jr. (4,786,053)**.

In reference to claims 2-3, Ferrari does not show a base having a T-shape and a pair of cross-member and longer members interconnected.

Barnes, Jr. shows, by using tubing and connectors the support structure can be arranged in a plurality of different ways, depending on the applicability, particular reference is made to Figure 4.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the base means of Ferrari to include tubular members as it is suggested by Barnes, Jr. in order to make it more easily assembled and disassembled, and also to allow the base to be put together in more than one form. The particular shape/configuration is considered an obvious choice of design because using and arranging tubing is well known in the construction of support structures.

In reference to claim 4, Ferrari shows the hoop means (16) is adjustable (40 and 42) on said support means (11) to raise or lower the height of said shoot means.

Regarding claim 5, the size of the hoop means is an obvious design choice absent any criticality.

In reference to claim 8, Ferrari shows a training aid (10) in which the adjustability of said hoop means (16) is also due to the telescoping adjustment of upper (12) and lower (32) pole members which comprise the support means, said upper pole member and said hoop means (16) being removably attached together.

Allowable Subject Matter

7. Claim 7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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Response to Arguments

8. Applicant's arguments filed 12/28/2000 have been fully considered but they are not persuasive. Ferrari's training device allows a player to stand under the hoop and make shots at any height necessary, since the height of the support stand is adjustable.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., hoop being in a horizontal position) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that 1) allows a player to stand under the hoop; and 2) allows a player to shoot an arc at any height necessary to make a shot, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In response to applicant's arguments against the references individually, one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keeler*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merci & Co.*, 800

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F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Barnes, Jr shows various support structures that can be made from different PVC type pipes, including a T-shape pipe (Figures 4, 8 and 9 items 100 and 101). The purpose of using Barnes, Jr's reference was to show that having a T-shaped support structure is not new and it is well known in the sports art, furthermore T-shape pipes can be used in different configurations.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is (703) 308-3550. The examiner


JEANETTE CHAPMAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

ATTACHMENT TO AND MODIFICATION OF
NOTICE OF ALLOWABILITY (PTO-37)
(November, 2000)

**NO EXTENSIONS OF TIME ARE PERMITTED TO FILE
CORRECTED OR FORMAL DRAWINGS, OR A SUBSTITUTE
OATH OR DECLARATION, notwithstanding any indication to the
contrary in the attached Notice of Allowability (PTO-37).**

If the following language appears on the attached Notice of Allowability, the portion lined through below is of no force and effect and is to be ignored¹.

A SHORTENED STATUTORY PERIOD FOR RESPONSE to comply with the requirements noted below is set to EXPIRE THREE MONTHS FROM THE "DATE MAILED" of this Office action. Failure to comply will result in ABANDONMENT of this application. ~~Extensions of time may be obtained under the provisions of 37 CFR 1.136.~~

Similar language appearing in any attachments to the Notice of Allowability, such as in an Examiner's Amendment/Comment or in a Notice of Draftperson's Patent Drawing Review, PTO-948, is also to be ignored.

¹ The language which is crossed out is contrary to amended 37 CFR 1.85(c) and 1.136. See "Changes to Implement the Patent Business Goals", 65 Fed. Reg. 54603, 54629, 54641, 54670, 54674 (September 8, 2000), 1238 Off. Gaz. Pat. Office 72, 99, 110, 135, 139 (September 19, 2000).